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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,672	03/18/2004	Tsutomu Okada	17548	5931
23389 7590 01/09/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER YABUT, DIANE D	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/803,672

Applicant(s)

OKADA, TSUTOMU

Examiner

Diane Yabut

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2007 has been entered.

### ***Claim Objections***

2. Claims 23 and 25 are objected to because of the following informalities: On line 14 of Claim 23 it reads "flexible s wire" and should read --flexible wire--. On line 2 of Claim 25 it reads "the as insertion" and should read --the insertion--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 29-30 are rejected under 35 U.S.C. 102(a) as being anticipated by **Muramatsu** (U.S. Pub. No. **20020133178**).

Claim 29: Muramatsu discloses a flexible insertion tube **1** capable of being inserted into a cavity of a living body, a flexible wire **4** having pliability and movably passed through the insertion tube, a junction provided on a distal end portion of the wire, detachably coupled with a clip **13** located at the distal end portion of the insertion tube for effecting grasping operation and disengaging operation of the clip, wherein the junction is pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation, the junction has a weak portion **14a** which is adapted to break when the wire is hauled with a tractive effort great enough to leave the clip and the junction includes a looped flexible wire of a predetermined length, one end of which is coupled with the clip and a joint **14c** connected to the flexible wire, the joint being coupled with the other end of the looped flexible wire, said one end of the looped flexible wire being able to be broken to release the clip (Figures 1A and 17, page 9, paragraphs 178-179).

Claim 30: Muramatsu discloses a flexible tube sheath penetrated by the insertion tube for advance and retreat, the tube sheath being capable of storing the clip located at the distal end portion of the insertion tube (page 3, paragraph 85).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsuno** (U.S. Patent No. **5,766,184**) in view of **Muramatsu** (U.S. Pub. No. **20020133178**).

Claims 23 and 27: Matsuno discloses a flexible insertion tube **28** capable of being inserted into a cavity of a living body, a flexible wire **33** having pliability and movably passed through the insertion tube, a junction provided on a distal end portion of the wire, detachably coupled with a clip **45** located at the distal end portion of the insertion tube for effecting grasping operation and disengaging operation of the clip, the junction including a looped flexible wire **37** of a predetermined length, one end of which is coupled with the clip and a coupling member connected to the flexible wire, the coupling member having a J-shaped portion ("hook") **30, 42** coupled with the other end of the looped flexible wire, the J-shaped portion being deformable and located apart from a distal end of the insertion tube in the insertion tube (col. 4, lines 28-32; Figures 5A-5B, 14).

Matsuno discloses the claimed device, except for the deformable J-shaped portion releasing the looped flexible wire so that the junction is broken, as well as the junction being pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation, the junction having a weak portion which is adapted to break when the wire is hauled with a tractive effort great enough to leave the clip.

Muramatsu teaches a deformable J-shaped portion **3f** that releases a looped flexible wire so that a junction is broken, as well as a junction being pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation (in that it is composed of a flexible metallic wire, page 4, paragraph 94), the junction having a weak portion which is adapted to break when the wire is hauled with a tractive effort great enough to leave the clip (Figure 3A, page 4, paragraph 107). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a deformable J-shaped portion or weak portion that releases a looped wire so that the junction is broken and a junction pliable enough to follow substantial bending deformation, as taught by Muramatsu, to Matsuno since it was well known in the art for releasably engaging linking members to have bendable or frangible portions and also to retain the clip in tissue and to bring the manipulating device to a location free of interference and making it more easy to manipulate and deliver subsequent clips (page 5, paragraphs 108-109).

Claim 24: Matsuno discloses a flexible tube sheath **3** penetrated by the insertion tube for advance and retreat, the tube sheath being capable of storing the clip located at the distal end portion of the insertion tube (Figure 14).

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsuno** (U.S. Patent No. **5,766,184**) and **Muramatsu** (U.S. Pub. No. **20020133178**), as applied to claim 23 above, and further in view of **Loshakove** (U.S. Pub. No. **20040087985**).

Claim 26: Matsuno and Muramatsu disclose the claimed device, except for the flexible insertion tube forming a push member for advancing the clip.

Loshakove teaches a flexible insertion tube **504** forming a push member for advancing a clip (Figure 5F and page 6, paragraph 104). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a flexible insertion tube that forms a push member for advancing a clip, as taught by Loshakove, to Matsuno and Muramatsu in order to eliminate the need for a separate mechanism or auxiliary pusher device, and simplify the manufacturing of the device.

8. Claims 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsuno** (U.S. Patent No. **5,766,184**) and **Muramatsu** (U.S. Pub. No. **20020133178**), as applied to claims 24 and 27 above, and further in view of **Matsui** (U.S. Patent No. **6,352,503**).

Claims 25 and 28: Matsuno and Muramatsu disclose the claimed device, including a part of the insertion tube being situated behind the clip and exposed from the distal end of the tube sheath and through which the looped flexible wires extends, except for a distal end part of the insertion tube forming a curvedly raised portion.

Matsui teaches a distal end part of an insertion tube forming a curvedly raised portion (Figures 48-50). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a curvedly raised insertion tube portion, as taught by Matsui, to Matsuno and Muramatsu since it was well known in the art to provide a curvedly raised tube in the use of side-viewing type endoscopes to effectively treat a

region of interest by front-viewing the region located in a hard-to-front-view position (col. 18, lines 40-45).

9. Claims 31 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Muramatsu** (U.S. Pub. No. **20020133178**), as applied to claims 29 and 30 above, and further in view of **Matsui** (U.S. Patent No. **6,352,503**).

Claims 31 and 33-34: Muramatsu discloses the claimed device, including a part of the insertion tube being situated behind the clip and exposed from the distal end of the tube sheath and through which the looped flexible wires extends, except for a distal end part of the insertion tube forming a curvedly raised portion being bent up to substantially 90 degrees by a forceps raising device.

Matsui teaches a distal end part of an insertion tube forming a curvedly raised portion being bent up to substantially 90 degrees by a forceps raising device (Figures 48-50). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a curvedly raised insertion tube portion bent up to substantially 90 degrees, as taught by Matsui, to Matsuno and Muramatsu since it was well known in the art to provide a curvedly raised tube in the use of side-viewing type endoscopes to effectively treat a region of interest by front-viewing the region located in a hard-to-front-view position (col. 18, lines 40-45).



10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Muramatsu** (U.S. Pub. No. **20020133178**) in view of **Loshakove** (U.S. Pub. No. **20040087985**).

Claim 32: Muramatsu discloses the claimed device, except for the flexible insertion tube forming a push member for advancing the clip.

Loshakove teaches a flexible insertion tube **504** forming a push member for advancing a clip (Figure 5F and page 6, paragraph 104). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a flexible insertion tube that forms a push member for advancing a clip, as taught by Loshakove, to Muramatsu in order to eliminate the need for a separate mechanism or auxiliary pusher device, and simplify the manufacturing of the device.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 23-35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

Application/Control Number:  
10/803,672  
Art Unit: 3734

Page 9

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DY

A handwritten signature in black ink, appearing to read "MJ Hayes", is written over a faint, larger signature that is partially visible in the background.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER